

REMARKS

Upon entry of the present amendment, the only claims remaining in the application are currently amended claims 1 and 5.

35 USC 132(a) OBJECTION

Claims 1 and 5 have been amended to comply with the new matter objection, and in connection therewith applicant respectfully directs attention to specification page 4, lines 21-24.

CLAIM OBJECTIONS

Claims 1 and 5 have been amended to correct the typo pointed out by the last OA.

CLAIM REJECTIONS – 35 USC 112

Claim 1 has been amended to avoid the confusion concerning the extender pointed out by the last OA.

CLAIM REJECTIONS – 35 USC 103

Applicant respectfully traverses the 35 USC 103 rejections of previous claims 1 and 5, especially in view of claims 1 and 5 as presently amended, based on the distinctions, reasons, authorities, and arguments set forth hereinbelow.

A primary and important feature of the present invention is using the extrusion method for granulation and adapting the disintegrant for solving the problems of absorption of the paraquat by utilizing an extender, for example, clay.

The products obtained by the extrusion method of the present invention contain only granules type without containing any powder whatsoever, which thus prevents inadvertent inhalation poisoning from scattered powder.

The product as defined by claim 1 and the method of preparing such product as defined by claim 5 specify the particular surfactant, the disintegrant, and the extender.

In contrast, the cited Yamashita et al. U.S. Patent 4,764,206, entitled "CONTRADEGLUTITIOUS SOLID HERBICIDAL COMPOSITION", ("Yamashita" herein), fails to disclose:

the disintegrant as specified by applicant's now-amended claims 1 and 5;

the wt% within the ranges as specified by applicant's now-amended claims 1 and 5;

the use of pyrophyllite as an extender as specified by applicant's now-amended claims 1 and 5;

the specific examples of surfactants as specified by applicant's now-amended claims 1 and 5; nor

applicant's method of preparing the water dispersible granule including drying the product of defined by applicant's step b), as specified by applicant's now-amended claim 5.

In further contrast, the cited Tadayuki et al. U.S. Patent 5,668,086, entitled "HERBICIDE COMPOSITION", ("Tadayuki" herein), fails to disclose:

any disintegrant (breakage promoter); nor

any extender.

Yet in still further contrast, the cited Mayer et al. U.S. Patent 6,030,924, entitled "SOLID FORMULATIONS", ("Mayer" herein), fails to disclose:

paraquat dichloride as an active ingredient;

pyrophillite as an extender; nor

any of the surfactants specified by applicant's now-amended claims 1 and 5.

And in still further contrast, the cited Phillips U.S. Patent 3,836,352, entitled "HERBICIDAL METHOD UTILIZING N-SUBSTITUTED HETEROCYCLIC COMPOUNDS", ("Phillips" herein), fails to disclose:

paraquat dichloride as an active ingredient;

the use of any surfactant; nor

the use of any disintegrant.

It is respectfully submitted that the following U.S. patent practice should apply to the situation as set forth hereinabove.

It is respectfully submitted that the cited references do not contain any suggestion (express or implied) that they be combined in the manner suggested in the last OA.

Also, it is respectfully submitted that each individual cited reference is complete and functional in and of itself, so there would be no reason to use parts from or add or substitute parts to or from any of the other three cited references, as suggested by the last OA.

Moreover, it is respectfully submitted that it would be necessary to make modifications, not taught or made obvious by the cited art, in order to combine the four cited references in the manner suggested by the last OA.

Furthermore, it is respectfully submitted that the cited references cannot be legally combined because they take mutually exclusive paths to reach different solutions to different problems, and, therefore, by implication each individual cited reference teaches away from combining itself with the other three cited references.

Additionally, applicant respectfully submits that if the present invention (as defined by applicant's now-amended claims 1 and 5) was in fact obvious, because of its great advantages, those skilled in the art surely would have implemented it by now. It is significant to note that the invention of the cited Phillips reference was made in 1969 (more than 36 years ago). That is, the fact that those skilled the art have not implemented the present invention, despite its great advantages, indicates that it is not obvious.

And very importantly, the fact that a large number of cited references (more than three) must be combined to meet the present invention is evidence in and of itself of unobviousness.

Applicant also respectfully directs attention to the following.

Unexpected Results: The results achieved by applicant's invention as defined in currently amended claims 1 and 5 are new, unexpected, superior, disproportionate, unsuggested, unusual, critical, and surprising.

Assumed Unworkability: Up till now, those skilled in the art thought or were skeptical that the techniques used in the present invention as currently claimed were unworkable or presented an insuperable barrier.

Assumed Insolubility: Up till now those skilled in the art thought or found the problem solved by the present invention to be insoluble. That is, the present invention converts failure into success. The failures of prior art workers indicates that a solution was not obvious.

Crowded Art: The present invention is classified in a very crowded art. Therefore, a small step forward should be regarded as significant and patentable.

Unsuggested Modifications: The cited art lacks any suggestion that any of the four cited references should be modified in the manner as suggested in the last OA.

Poor References: The four cited references are conflicting, and, therefore, are weak and should be construed strictly and narrowly.

Solution of Long-Felt and Unsolved Need: The present invention solves a long-felt, long-existing, but unsolved need.

Contrarian Invention: The present invention is contrary to the teachings of the cited art; that is, the present invention goes against the grain of what the cited art teaches.

Strained Interpretation: It is respectfully submitted that the last OA makes a strained interpretation of the four cited references, which could be made only by hindsight after having been exposed to what applicant teaches in the present patent application.

New Principle of Operation: The present invention utilizes a new principle of product formulation. Applicant has blazed a trail, rather than followed one.

No Convincing Reasoning: It is respectfully submitted that the last OA does not present a convincing line of reasoning as to why the subject matter as a whole, especially as defined in the currently amended claims 1 and 5, including its differences over the cited art, would have been obvious.

Unsuggested Combination: None of the four cited references contain any suggestion (express or implied) that they be combined, or that they be combined in the manner suggested in the last OA.

Claimed Features Lacking: It is respectfully submitted that even if combined, the cited references would not meet the claims as set forth in currently amended claims 1 and/or 5.

Synergism: It is respectfully submitted that the whole (that is, the result achieved by the present invention) is greater than the sum of its parts (that is, the respective results of the individual cited references).

With regard to the combination of Yamishita, Tadayuki, Mayer, and Phillips as suggested by the last OA, it is well known that in order for any prior-art references themselves to be validly combined for use in a prior art § 103 rejection, *the references themselves* (or some other prior art) must suggest that they be combined. E.g., as was stated in In re Sernaker, 217 U.S.P.Q. 1,6 (C.A.F.C. 1983):

“[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings”.

That the suggestion to combine the references should not come from applicant was forcefully stated in Orthopedic Equipment Co. v. United States, 217 U.S. P.Q. 193, 199 (C.A.F.C. 1983):

“It is wrong to use the patent in suit [here the patent application] as a guide through the maze of prior art references, combining the right references in the right way to achieve the result of the claims in suit [here the claims pending]. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law [here the PTO]”.

As was further stated in Uniroyal, Inc. v Rudkin-Wiley Corp., 5 U.S.P.Q. 2d 2434 (C.A.F.C. 1988) “[w]here prior art references require selective combination by the court to

render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself...*Something in the prior art must suggest the desirability and thus the obviousness of making the combination.*" [Emphasis supplied].

In line with these decisions, the Board stated in Ex parte Levengood, 28 U.S.P.Q. 2d 1300 (P.T.O.B.A.&I. 1993):

"In order to establish a *prima facie* case of obviousness, it is necessary for the examiner to present *evidence*, preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art *would have been led* to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention...That which is within the capabilities of one skilled in the art is not synonymous with obviousness...That one can *reconstruct* and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention... Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in that art, that 'would lead' that individual 'to combine the relevant teachings of the references.' ...Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done."

Furthermore, the fact that the applied references each teach features aimed at solving different problems is not sufficient to gratuitously and selectively substitute parts of one

reference, for a part of another reference in order to meet applicants' claimed invention.

As stated in the above Levengood case, "That one can *reconstruct* and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention".

Applicant therefore respectfully submits: that the last OA fails to establish a *prima facie* case of obviousness; and that combining the four cited references is not legally justified and is therefore improper. Thus, applicant respectfully submits that the rejection on these references is also improper and should be withdrawn.

It is respectfully submitted that the application is now in condition for allowance, and a notice to this effect is earnestly solicited.

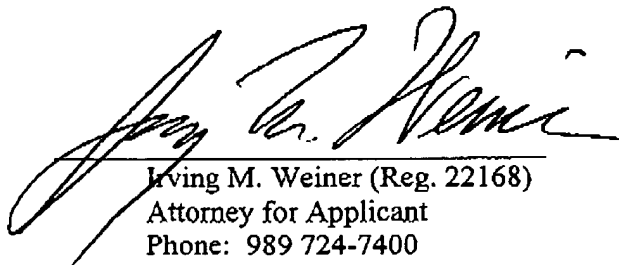
If the Examiner believes that the application is not now in condition for allowance, it is respectfully requested that the Examiner telephone the undersigned attorney for applicant in an effort to facilitate the prosecution, and/or to narrow the issues for appeal.

Applicant has simultaneously filed herewith a Notice of Appeal.

Favorable reconsideration is respectfully requested.

Respectfully submitted,

Date: June 2, 2006
Weiner & Burt, P.C.
635 N. US-23
POB 186
Harrisville, MI 48740


Irving M. Weiner (Reg. 22168)
Attorney for Applicant
Phone: 989 724-7400
Fax: 989 724-7100